

### **REMARKS**

Claims 1, 35-59, 68, and 69 are pending in this application. Claims 2-34 and 60-67 are canceled. Claims 1, 35, and 49 are amended in this response. Claims 68 and 69 are added. No new matter is added. Claims 1, 35-60, and 64 are rejected.

#### **I. Rejections of Claims 1, 35-60 and 64 Under 35 U.S.C. § 112, First Paragraph**

Claims 1, 35-60 and 64 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. *See* Office Action at pp. 2-3. Regarding claims 1 and 35, the Examiner asserts that the term “linked” is unsupported. Claims 1 and 35 are amended to remove the term “linked,” thus rendering this rejection moot. Regarding claims 60 and 64, these claims are canceled in this response, thus rendering this rejection moot. Hence, the applicants request that the rejection of claims 1 and 35 under 35 U.S.C. § 112, first paragraph, be withdrawn.

#### **II. Rejections Under 35 U.S.C. § 103(a).**

Claims 1 and 35-59 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,014,645 to Cunningham (“Cunningham”) in view of “VISA, MBNA and De La Rue Launch Multi-Function Smart Card Program,” De La Rue PLC 7/06/1998 (“De La Rue”). *See* Office Action at pp. 4-17.

Claims 1 and 35 recite a method for activating a multi-value card having at least one feature and at least one optional secondary feature (claim 1) or “features” (claim 35). Claim 1 includes the limitation of “wherein an application for the multi-value card is processed as part of an integrated application process whereby the primary multi-value card use, the secondary credit card feature and any additional use features are established in response to a single customer application, and wherein the primary multi-value card use, the secondary credit card feature and any additional use features are associated with the multi-value card prior to issuance of the multi-value card with each feature capable of being activated after issuance.” Claim 35 includes a similar limitation. Applicants respectfully submit that neither Cunningham nor De La Rue, alone or in combination, discloses these limitations of claims 1 and 35 and, therefore, these references do not support a *prima facie* case of obviousness.

Cunningham discloses a system for presenting financial card offers to potential customers. *See* Abstract. The system of Cunningham “allows users to peruse and accept financial card offers from financial institutions interested in locating customers who meet specific selection criteria.” Col. 2, lines 12-15. The user is prompted to provide “pertinent information,” and additional information may be obtained using the information provided by the user. Col. 2, lines 15-18. The user is assigned a “financial risk rating” or “grade/score” which can be used to identify financial card offers. Col. 2, lines 18-23. The user can accept an offer, and the user is sent a financial card in accordance with the offer. Col. 2, lines 24-29. Cunningham does not teach or suggest a single card having multiple features, e.g., transaction card features and credit card features, thus Cunningham does not teach or suggest activation of such features.

De La Rue is a press-release type of document that is conceptual and provides little detail with respect to enablement. De La Rue discloses a program that combines credit, stored value, and loyalty functions on a single smart card. *See* De La Rue at p.1, para. 1. De La Rue does not teach or suggest how the different features of the smart card are activated.

With respect to the previous version of claim 1 of the present application, the Examiner admits that, “Cunningham does not explicitly disclose the steps of ... wherein an application for the multi-value card is processed as part of an integrated application process whereby the features of the multi-value card are established in response to a single customer application and wherein the features of the multi-value card are linked as of the time the multi-value card is issued or activated.” For this limitation, the Office Action attempts to rely on De La Rue. De La Rue does not teach or suggest the limitation recited in amended claim 1. Specifically, De La Rue does not teach or suggest a multi-value card having different features which can be activated using an integrated activation process as recited in claim 1. Specifically, De La Rue does not teach or suggest that “the primary multi-value card use, the secondary credit card feature and any additional use features are associated with the multi-value card prior to issuance of the multi-value card with each feature capable of being activated after issuance” as recited in amended claim 1.

This differentiation is further distinguished with respect to claim 35 of the present application in which the applied art does not teach or suggest “a first activation activating at least one feature of the multi-value card; ... offering to the customer a subsequent activation of the multi-value card to add at least a second feature; ... wherein an application for the multi-value card is processed as part of an integrated application process whereby the features of the multi-value card are established in response to a single customer application and wherein the features of the multi-value card are associated with the multi-value card prior to issuance of the multi-value card.” (Emphasis added).

Hence, the applied art does not teach or suggest each and every limitation recited in claims 1 and 35. Specifically, the applied fails to teach or suggest that “an application for the multi-value card is processed as part of an integrated application process whereby the primary multi-value card use, the secondary credit card feature and any additional use features are established in response to a single customer application, and wherein the primary multi-value card use, the secondary credit card feature and any additional use features are associated with the multi-value card prior to issuance of the multi-value card with each feature capable of being activated after issuance” as recited in claim 1 of the present application. The applied art fails to teach or suggest that “an application for the multi-value card is processed as part of an integrated application process whereby the features of the multi-value card are established in response to a single customer application and wherein the features of the multi-value card are associated with the multi-value card prior to issuance of the multi-value card” as recited in claim 35 of the present application. By having the features associated with the multi-value card at issuance, each feature can be activated at various times without having to issue a new card.

Moreover, with respect to claim 1, the Office Action asserts that Col. 3, lines 23-26 of Cunningham teaches or suggests “providing a least one or more safety features to determine whether said customer is the person whose name is printed on the said multi-value card.” *Office Action*, p. 4. This cited section of Cunningham discloses the use of a firewall for security purposes. The disclosure of a firewall does not relate to determining if the customer is the

person whose name is printed on the multi-value card. Thus, Cunningham fails to teach or suggest this limitation. De La Rue is not cited for teaching or suggesting this limitation.

In addition, with respect to claim 1, the Office Action asserts that Col. 4, line 65 - Col. 5, line 5 of Cunningham teaches or suggests "confirming the customer's desire to activate the primary multi-value card use." *Office Action*, p. 4. This cited section of Cunningham discloses a user accepting an offer and the financial institution who made the offer makes arrangements to send the financial card to the applicant. Sending a financial card is not the same as "confirming the customer's desire to activate the primary multi-value card use" since, as is known in the industry, the customer will have to call a number in order to activate the financial card. . Thus, Cunningham fails to teach or suggest this limitation. De La Rue is not cited for teaching or suggesting this limitation.

Lastly, with respect to claim 1, the Office Action asserts that the Abstract of Cunningham teaches or suggests "wherein prior to the activation of the primary feature or any secondary features, the multi-value card contains or is associated with information related to the primary feature and the one or more optional features (Abstract 'The applicant peruses the offers and chooses one that meets his or her needs.' Perusing information associated with the primary card offer.)" *Office Action*, p. 5. The Office Action makes a similar assertion with respect to claim 35. Claims 1 and 35 of the present application do not recite such a limitation, thus the Applicants will not address this assertion at this time and reserves the right to address this assertion at a later time.

Accordingly, Cunningham and De La Rue in combination do not support a *prima facie* case of obviousness because they do not disclose each and every limitation of claims 1 and 35. Applicants respectfully submit that these rejections be withdrawn.

Further, since claims 36-59, 68, and 69 are dependent on independent claims 1 and 35, respectively, the rejections under 35 U.S.C. § 103(a) over Cunningham and De La Rue should be withdrawn over these additional claims for the same reasons. Therefore, the Applicants will not address the arguments with respect to these claims and reserves the right to address these

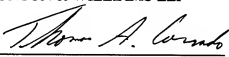
arguments at a later time. For the foregoing reason, Applicants respectfully request that the rejections be withdrawn.

**CONCLUSION**

For at least the reasons outlined above, Applicant respectfully asserts that the application is in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully solicited. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below. For any fees due in connection with filing this Response the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,  
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